

REMARKS

Claims 1-22 were pending in this application. Claim 17 has been amended for clarification purposes with respect to more clearly defining the operation of the "Auto-run" feature, which Applicant believes was inherent in original claim 17. Therefore, Applicant's clarifying amendment does not introduce any unexamined subject matter. No claims have been added or cancelled. Accordingly, claims 1-22 remain in this application.

Applicant concurrently submits a Declaration Under 37 C.F.R. § 1.132 (hereinafter referred to as "*Declaration*") signed by the Inventor, Mr. Constantine Domashnev, as well as an exemplary survey mailing (hereinafter referred to as "*Survey Card*") outlining the questions posed in a survey conducted by Mr. Domashnev.

35 U.S.C. §103 Rejections

Independent claims 1 and 13 stand rejected under 35 U.S.C. § 103(a) for obviousness over newly cited U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of previously cited U.S. Patent Application Publication No. 2003/0195838 to Henley.

With respect to claims 1 and 13, the Examiner asserts that Applicant is separating the entities into separate servers as a matter of design choice, and is therefore not considered to be a patentable distinction. However, the design choice rule of law does not apply to the instant case because Applicant has set forth relationship-defining limitations that have structural and operational differences attributed thereto. Specifically, the claims describe how the first computer is functionally distinct from the first computer and how the first computer is operated by a physician, whereas the server is operated by a service provider. The novelty of the present invention, among other things, is that the service provider would review the incoming bids, as opposed to having the bids come in to the computer operated by the physician. Therefore, it would not make sense to have the service provider work on the same computer of the physician. Otherwise, the service provider would need to visit every single physician's computer, which defeats the purpose of the service provider implementation of the claimed invention.

In §3(a) of his *Declaration*, Mr. Domashnev declares:

The deficiency of the system disclosed in the Munoz publication, among other things, lies in the fact that physicians are charged with the task of collecting, reviewing, and forwarding the bids to the patient, in paper form, nonetheless. In practice, the physicians will not have time to review all the bids and the

workload will be increased for them. This, in effect, increases the cost of the prescription (i.e., increased overhead costs need to be passed on to the patient), which is opposite to the intended goal of the present invention. The service provider of the present invention undertakes this aforementioned increased overhead. Specifically, the patient is allowed to view and select from the offered bids via their own computer. The physician's duties therefore only extend to submission of the prescription, which is no different or incurs greater effort and resources, than is currently employed by a physician. It is more effective to allow the patient to view and select from the various bids because multiple criteria is to be taken into account. The patient's decision will be based, among other things, on geographic location, proximity to commuting routes, immediate availability, discount cards with some specific pharmacies, etc. It is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. For example, if the cost of the medication was the only criteria, all patients would drive to Canada for their prescriptions. However, the cost of gas and time budgeting are part of the equation, as well.

Accordingly, Mr. Domashnev does not view the Munoz publication to contain any suggestion or motivation for one skilled in the art of ASP medical-based computing implementations to utilize the teachings of the Munoz publication in the context of an electronic prescription handling system according to the claimed invention.

The Examiner asserts that use of the term "service provider" for purposes of distinguishing the claimed invention from the prior art represents an intended use of the claimed server. However, the term "service provider", as is known in the art, is an entity that provides a service. With respect to the present invention, the service provider acts as an intermediary to offload the involved task of a physician collecting, reviewing, and forwarding bids to a patient. The term "service provider" therefore, at least with respect to the method claim 13, cannot be viewed as purely an intended use limitations, as the requirement that the server be operated by the service provider is a recitation of a positive step in the method, as with any of the other steps.

The Examiner asserts that Applicant has failed to specifically recite the claim limitation "reverse auction" to describe what is occurring. However, the reverse auction concept is inherent in the claimed steps of the invention and, therefore, there is no reason to refer to the concept by name, regardless of whether or not a reverse auction is occurring. The Examiner is respectfully requested to examine the merits of the claims based upon the wording selected by Applicant.

Furthermore, regardless of whether or not Applicant implicitly or explicitly claims a “reverse auction”, the Examiner fails to show the “reverse auction” aspect in the context of combined teachings of the prior art. The Examiner states that the Henley publication describes other types of auctions. Although this may be correct, the Examiner has not set forth a “reverse auction” type rejection. The Examiner offers the accepted tenet that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. Applicant agrees with this principle, however, it does not apply to the facts at issue. An obviousness rejection must be based upon the teachings of two or more references that together, disclose all claim limitations. What Applicant has previously done was argue how the Henley publication does not teach a reverse auction because there isn’t a second computer configured to select from among various bids and to instruct the winning pharmacy to fill the prescription. Thus, Applicant argued that because there is no reverse auction teaching in the Henley publication that the Henley publication cannot serve as an underlying anticipation reference for forming an obviousness rejection. It is settled law that “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Brothers Inc. v. Union Oil Co. of California*, 2 USPQ2d, 1051, 1053 (Fed. Cir. 1987). Accordingly, any subsequent Office Action rejecting the claims cannot be deemed to be a final Office Action because the Examiner has failed to make reference to a disclosure outlining a “reverse auction”.

In §3(b) of his *Declaration*, Mr. Domashnev declares:

In the Henley publication, there is a disclosure with respect to “registered buyers” (e.g., patients) who have the ability to log-in to a computer system using their own computer for purposes of buying prescriptions at offered prices set forth by vendors. However, this disclosure in the Henley publication is akin to a traditional auction, as opposed to the reverse auction of the present invention. This assertion is supported by the fact that “registered buyers” in the Henley system can outbid other “registered buyers”. However, the present invention is more than just a reverse auction in that a user (i.e., the patient) of the service is provided with multiple choices and trade-offs with respect to formulating a decision as to which pharmacy to utilize in filling the prescription. For example, convenience of picking up the medication and availability of the medication are factors which may cause the user to select a more expensive bid. Neither the Munoz nor Henley publications, either alone or in combination, disclose, teach, or suggest an ASP-based electronic prescription handling system comprising an auction conducive to multi-objective prescription choices offered to a patient.

Accordingly, Mr. Domashnev does not view either the Munoz or Henley publications to contain any suggestion or motivation for one skilled in the art of ASP medical-based computing implementations to utilize the teachings of the Munoz or Henley publications in the context of an electronic prescription handling system according to the claimed invention.

Dependent claims 10 and 11 stand rejected under 35 U.S.C. §103(a) for obviousness based upon the Munoz publication in view of the Henley publication, further in view of U.S. Patent Application Publication No. 2003/0154376 to Hwangbo, and further in view of U.S. Patent Application Publication No. 2002/0035484 to McCormick. Claims 10 and 11 relate to directions and mapping of the pharmacies, which is beneficial to the patient in making informed decisions as to which pharmacy to select at the time of making a bid. As discussed in §3(b) of his *Declaration*, “[t]he patient’s decision will be based, among other things, on geographic location, proximity to commuting routes...” Thus, providing directions and mapping of pharmacies, among other things, is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. Furthermore, the motivation for combination of the teachings of the prior art provided by the Examiner is improper as it relates to “eliminating inefficiencies at the doctor’s office in generating the prescriptions”. Applicant fails to understand how providing directions and maps would improve on generating prescriptions more efficiently. Accordingly, the Examiner has failed to set forth a prima facie case of obviousness with respect to claims 10 and 11.

Independent claim 17 stands rejected under 35 U.S.C. §103(a) for obviousness based upon U.S. Patent Application Publication No. 2002/0065758 to Henley in view of U.S. Patent Application Publication No. 2001/0039503 to Chan and U.S. Patent Application Publication No. 2002/0010679 to Felsher. The Examiner continues to assert that the “auto-execute” functionality has not been claimed. As is known in the art, the auto-run feature of Windows utilizes a script file “autorun.inf” that is found on the loaded media that is recognized by the OS, which in turn causes the associated executable file to run (See §4 of *Declaration*). Applicant believes that the issue of auto-execution is a matter of semantics and has therefore amended independent claim 17 for clarification purposes.

In his *Declaration*, Mr. Domashnev declares how “[t]here is an unfulfilled need in the electronic prescription industry to provide a system and method for providing a physician with authenticated access to generate a prescription from any Internet-connected

computer, whereby a patient for whom the prescription is written invites bidding on his or her prescription in order to realize cost savings over market-priced drugs in the context of multi-objective prescription choices” (See §5 of *Declaration*). This assertion is supported not only by the lack of an anticipatory reference disclosing all of the claimed elements of such a system and method, but also by a survey conducted by Mr. Domashnev of various physicians. Specifically, the survey consisted of the *Survey Card* being mailed to at least 500 physicians in the Pittsburgh area. The attached *Survey Card* asked if the physician was interested in:

“an automated prescription process that might save you time and effort and provide you with great flexibility”

“a system that, if need be, would allow you to write prescriptions from anywhere in the world”

“a system that would allow you to lookup all available medications and their uses before prescribing medication to a patient”

“a system that would print out information on all available medications including available forms, possible side effects, past uses for treatments, etc.”

“a system that would allow you to automatically send the prescription to an online prescription auction site that would find the best price for the prescription for your patient”

Another question that was asked was: “If the automated prescription process had the above functionality, would you use it?” to which the majority of responding physicians answered “yes,” which leads to the conclusion that the majority of physicians indicated that they would be interested in the present invention (See §2 of *Declaration*). Additionally, the majority of physicians indicated that they would pay a monthly fee for such a system. Specifically, about 15% indicated that they would pay \$200 a year for use of such a system, about 68% indicated that they would pay \$20 a months for use of such a system, and about 15% indicated that they would pay \$50 a month for use of such a system.

When undertaking an obviousness analysis, the Examiner is also required to take into account secondary considerations, such as long-felt need, for the applicant’s invention. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Accordingly, the fact that the aforementioned survey questions were answered in the affirmative should be

evidence of an existing long felt need for the claimed electronic prescription handling system, which therefore weighs in favor of overcoming the Examiner's obviousness rejection.

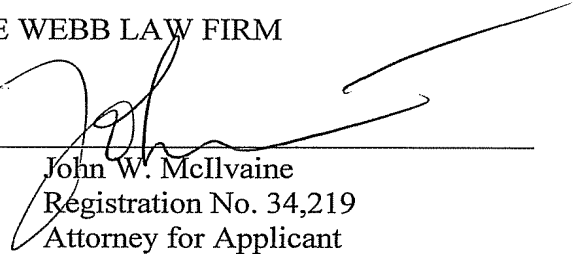
For the foregoing reasons, Applicant believes that the subject matter of independent claims 1, 13, and 17 is not rendered obvious by the prior art of record and, therefore, respectfully requests reconsideration of the rejections of independent claims 1, 13, and 17. Claims 2-12, 14-16, and 18-22 depend from and add further limitations to independent claims 1, 13, and 17, respectively, and are believed to be patentable for the reasons discussed hereinabove in connection with independent claims 1, 13, and 17.

CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-22 are respectfully requested.

Respectfully submitted,
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